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EXAMINER

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The time period for reply, if any, is set in the attached communication.



### **DETAILED ACTION**

Applicant's amendments and arguments received 10/562,199 have been entered and considered. Claims 1-34, and 43 have been canceled. An examination of pending claims 35-42 and 44-78 is herein presented.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 35-42, and 44-57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Garrett (US Patent 6,926,241).

a. Regarding claim 35, Garrett discloses an apparatus (Fig. 21,22; abstract) comprising a covering arrangement (tarp – column 22, lines 15-19) suitable for covering a water tank which can be mounted onto an external portion of a building (column 10, lines 65-68; column 11, lines 1-3), said covering arrangement being made in the predetermined three dimensional shape of an architectural component (rectangular shape) of the building (tarp can conform to any shape, including rectangular), wherein said apparatus further comprises an adjustable angular positing device (Fig. 1,21,22) being configurable as to keep said tank in a substantially vertical position. Garret does not disclose how the covering decoratively appears. However, matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably

distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (CCPA 1947). Here, whether the covering is red to match a brick house or brown to match a wooden house, etc, the design does not affect how the cover functions. Therefore, it would have been obvious to one of ordinary skill in the art to form Garrett with any type of ornamentation, including having the architectural component being architecturally and aesthetically harmonized with different buildings or styles of buildings, as this would have merely been picking between different non-functional, decorative designs.

b. Regarding claim 36, Garret discloses a water tank (Fig. 21). Garret does not disclose that the water tank has a convex bottom and the angular positioning device has one or more concave abutting elements to receive a concave bottom. However, it is notoriously well known in the art to change the shape of a shelf or support member to match the element to be supported. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a concave holding service if intended to be used with a convex member.

c. Regarding claims 37 and 44, said angular positioning device comprises a seat (Fig. 21,22) arranged for housing said tank therein, and an anchoring element (510,512) for anchoring to said external portion.

d. Regarding claims 38 and 45, said seat and said anchoring element are disposed in opposite portions (top, bottom) of a positioning shell element (frame).

e. Regarding claims 39 and 46, said seat is disposed in a first positioning shell element (top frame 518).

f. Regarding claims 40 and 47, said anchoring element is obtained in a second positioning shell element (bottom frame) hinged (via 520) on said first positioning shell element.

g. Regarding claims 41 and 48, said seat is shaped such that a longitudinal axis of a tank can be arranged vertically by rotating said first positioning shell element in relation to said second positioning shell element (Fig. 21,22).

h. Regarding claim 42, Garrett discloses a covering arrangement (tarp column 22, lines 15-19) suitable for covering a component of an air-conditioning system that can be mounted onto an external portion of a building, said covering arrangement being made in the predetermined three dimensional shape of an architectural component (rectangular) of the building (as a tarp can take any shape, such as the rectangular shape), and an adjustable angular positing device (Fig. 1,21,22) being configurable as to keep said tank in a substantially vertical position. Garret does not disclose how the covering decoratively appears.

However, matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (CCPA 1947). Here, whether the covering is red to match a brick house or brown to match a wooden house, etc, the design does not affect how the cover functions.

i. Regarding claim 49, said external portion comprises a roof (Fig. 21,22).

j. Regarding claim 50-55, Garret discloses the invention as claimed except for how the covering decoratively appears. However, it would have been a

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matter of obvious design choice to form the architectural component as any type of decorative design, including a chimney cap, skylight, attic skylight, veranda, balcony, column, arch, wall arrangement, wall arrangement with a window, wall arrangement with a grille, wall arrangement made of bricks or wall arrangement made of panels, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966). In addition, the changes in shape merely affect the ornamentation of the cover; it does not affect how the cover functions or operates. Matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (CCPA 1947). Here, each of the shapes serve no mechanical function; the shapes are merely different types of designs meant to hide an unattractive object. Any type of shape could be chosen for its different decorative purpose.

k. Regarding claims 56-57, Garrett discloses the invention as claimed except for what material comprises the architectural component. However, it would have been a matter of obvious design choice to form panel sections out of a material that resists atmospheric agents such as glass fiber, A.B.S., polycarbonate, polystyrene or sheet metal, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its

suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

3. Claims 35, 37, 42, 49-51, 53, and 69-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelmson (US Patent 6,093,098) in view of Merideth (US Patent 5,454,538).

a. Regarding claim 35, Wilhelmson discloses an apparatus comprising a covering arrangement (10) suitable for covering a water tank which can be mounted onto an external portion of a building, said covering arrangement being made in the predetermined three dimensional shape of an architectural component (chimney) of the building, the architectural component being architecturally and aesthetically harmonized with the external portion of the building or architectural style of the building (Fig. 1,2), and an angular position device (28) being configurable so as to be able to keep a tank in substantially vertical position. Wilhelmson does not disclose the angular positioning device (28) being an adjustable angular positioning device. However, it is notoriously well known to make positioning devices adjustable. For example, Merideth teaches an adjustable angular positioning device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilhelmson to use an adjustable angular positioning device, such as taught by Merideth, in order to be able to account for the different irregularities and shapes of roofs. Furthermore, it would have been obvious to one having ordinary skill in the art at the same time the invention was made to make the positioning device

adjustable, as it has been held that adjustability, where needed, is not a patentable advance. In re Stevens , 101 USPQ 284.

b. Regarding claims 37 and 44, the angular positioning device comprises a seat arranged for housing, or capable of housing, a tank therein, and anchoring element (14) for anchoring to said external portion (Fig. 2).

c. Regarding claim 42, Wilhelmson discloses an apparatus comprising a covering arrangement suitable for covering a component of an air-conditioning system which can be mounted onto an external portion of a building (Fig. 1,2), said covering arrangement being made in the predetermined shape of an architectural component of the building (Fig. 2), the architectural component being architecturally and aesthetically harmonized with the external portion of the building or architectural style of the building, and an angular position device (28) being configurable so as to be able to keep a tank in substantially vertical position. Wilhelmson does not disclose the angular positioning device (28) being an adjustable angular positioning device. However, it is notoriously well known to make positioning devices adjustable. For example, Merideth teaches an adjustable angular positioning device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilhelmson to use an adjustable angular positioning device, such as taught by Merideth, in order to be able to account for the different irregularities and shapes of roofs. Furthermore, it would have been obvious to one having ordinary skill in the art at the same time the invention was made to make the positioning device adjustable,



as it has been held that adjustability, where needed, is not a patentable advance.

In re Stevens , 101 USPQ 284.

d. Regarding claim 49, said external portion comprises a roof (Fig. 1,2).

e. Regarding claim 50, said component has a shape of a chimney cap (Fig. 1,2).

f. Regarding claim 51, said covering arrangement comprises a wall arrangement.

g. Regarding claim 53, said wall arrangement furthermore comprises a grille (Fig. 2).

h. Regarding claims 69 and 72, said covering arrangement comprises at least one structural side wall dimensioned to be able to hide a water tank from view (Fig. 1,2).

i. Regarding claims 70 and 74, said covering element comprises a top element (Fig. 1,2), said top element in combination with said at least one side wall forming an interior space capable of enclosing a water tank.

j. Regarding claims 71 and 75, the covering arrangement is harmonized with the building (Fig. 1,2).

k. Regarding claim 73, said at least one side wall comprises a plurality of side walls (Fig. 1,2).

l. Regarding claim 76, Wilhelmson discloses an apparatus comprising covering means for covering a functional, non-architectural component mounted onto an external portion of a building in such a way that the component is

substantially hidden from view (Wilhelmson's cover 10 is functionally equivalent to applicant's cover 1), means for architecturally and aesthetically harmonizing the covering means with the external portion of the building or the architectural style of the building (Wilhelmon's cover 10 appears to be a chimney and matches the house in Fig. 1 like how applicant's cover appears to be a chimney and matches the house in Fig. 14), and an angular position device (28) being configurable so as to be able to keep a tank in substantially vertical position. Wilhelmson does not disclose the angular positioning device (28) being an adjustable angular positioning device. However, it is notoriously well known to make positioning devices adjustable. For example, Merideth teaches an adjustable angular positioning device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wilhemson to use an adjustable angular positioning device, such as taught by Merideth, in order to be able to account for the different irregularities and shapes of roofs. Furthermore, it would have been obvious to one having ordinary skill in the art at the same time the invention was made to make the positioning device adjustable, as it has been held that adjustability, where needed, is not a patentable advance. In re Stevens , 101 USPQ 284. The modified adjustable positioning device then serves as a means for adjustably maintaining said functional, non-architectural component in a substantially vertical position (functionally equivalent to applicant's Fig. 9).

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- m. Regarding claims 77 and 78, Merideth further teaches that the adjustable angular positioning device includes a bottom face (bottom of 20) adapted to be positioned against a roof (Fig. 1) of the building in use, and a support surface (top of 22) for the tank or air conditioning system, the support surface being adjustable relative to the bottom surface (Fig. 4-6).
4. Claims 58-60 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Soloman (US Patent 5,989,656) in view of Blue Hill Avenue.
- a. Regarding claim 58, Solomon discloses a method of forming an image (floral image), disposing the image on a layer element (net) and applying said layer element onto a supporting surface element (frame of the utility box or air conditioner) surrounding a functional non-architectural element (utility box, air conditioner), the functional non-architectural element being disposed on the building. Solomon does not disclose that the image can be of a selected part of a building. However, it is well known in the art that one type of decorative image that can be used is an image of a selected part of a building. For example, Blue Hill Avenue discloses a method comprising forming an image of a selected part of a building (window), disposing the image on a layer element (board), and applying said layer element onto a supporting surface element surrounding a functional element, the functional element being disposed on the building (See figs.) It would have been obvious to one of ordinary skill in the art to modify Solomon to use an image of a selected part of a building, such as taught by Blue Hill Avenue, in order to create a different decorative effect. Furthermore, the

selected images appear to be mere ornamentation; matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (CCPA 1947).

b. Regarding claim 59, the supporting surface element is part of a covering arrangement enclosing said functional non-architectural element.

c. Regarding claim 60, the supporting surface element is comprised in an external surface (frame of the utility box or air conditioner) of said functional non-architectural element.

d. Regarding claim 68, the functional non-architectural element comprises a component of an air-conditioning system.

5. Claims 58-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (US Patent 3,742,659) in view of Cherkas et al. (US Patent 5,858,494).

a. Regarding claim 58, Drew discloses a method for a building wherein there is a functional non-architectural element with a cover (abstract; Fig. 1). Drew does not disclose that element is disguised by the method of forming an image of a selected part of a building, disposing the image onto a layer element and then applying said layer element onto a supporting element surrounding a functional non-architectural element. However, it is notoriously well known in the art that different items can be decorated. It is also notoriously well known in the art that a method of decorating an object can comprise reproducing a selected part of an original to get an image therefrom, disposing the image onto a layer element and

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then applying the layer element onto a support surface element. For example, Cherkas et al. discloses the method of decorating an object (lure) can comprise reproducing, or forming, a selected part of an original (fish) to get an image therefrom, disposing the image onto a layer element and then applying the layer element onto a support surface element (abstract). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Drew to use the method of creating decorations, wherein of the decorating of an object can comprise reproducing, or forming, a selected part of an original to get an image therefrom, disposing the image onto a layer element and then applying the layer element onto a support surface element, such as taught by Cherkas et al., in order to better disguise and blend in the architectural element.

Furthermore, what image is being selected appears to be mere ornamentation; matters relating to ornamentation only which have no mechanical function cannot be relied upon to patentably distinguish the claimed invention from the prior art. In re Seid, 73 USPQ 431 (CCPA 1947).

- b. Regarding claim 59, the supporting surface is part of a covering arrangement enclosing said functional non-architectural element (Fig. 1).
- c. Regarding claim 60, the supporting surface element is on an external surface of the functional non-architectural element (Fig. 1).
- d. Regarding claim 61, Cherkas et al. further discloses the image can be obtained using a photographic device (camera).

- e. Regarding claim 62, the image is transferred onto a supporting film, so as to form a covering layer (abstract).
  - f. Regarding claim 63, applying the covering layer can comprise winding the layer element around the covering arrange housing said functional non-architectural element.
  - g. Regarding claim 64, applying comprises inherently mutually engaging opposite edge of the layer element.
  - h. Regarding claim 65, while Drew in view of Cherkas et al. is silent as to the shape of the covering arrangement, it would have been a matter of obvious design choice to form the architectural component as any type of decorative design, including a chimney cap, skylight, attic skylight, veranda, balcony, column, arch, or wall arrangement, as such a modification would have involved a mere change in shape of a component. A change in shape is generally recognized as being within the level of ordinary skill in the art. In re Dailey, 149 USPQ 47 (CCPA 1966).
  - i. Regarding claim 68, the functional non-architectural element can be an air-conditioning system (column 1, lines 15-68).
6. Claims 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drew (US Patent 3,742,659) in view of Cherkas et al. (US Patent 5,858,494 as applied to claim 58 above, and further in view of Garrett (US Patent 6,926,241).
- d. Regarding claims 66-67, Drew in view of Cherkas et al. discloses equipment can comprise the functional non-architectural element (column 1, lines

7-10). While Drew does not specifically state that the equipment can be a water tank in a solar panel system or an air-conditioning system, it is notoriously well known in the art that a type of equipment to be mounted and covered on a roof can include a water tank with a solar panel system. For example, Garrett discloses a water tank in a solar panel system (paragraph 83) can be housed in an apparatus. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Drew in view of Cherkas et al. to include a water tank in a solar panel system, such as taught by Garrett, in order to supply hot water to a building.

### ***Response to Arguments***

7. Applicant's arguments filed 09 May 2011 have been fully considered but they are not persuasive. Applicant argues that Garret uses a tarp, and tarps are flat. However, as stated in the Non-final Office action mailed 09 November 2010, "the shape of an architectural component" is a very broad limitation. For example, applicant admits that skylights are architectural components, and skylights can have a flat shape. Another architectural component is a chimney, which has a rectangular shape. When the flat tarp is placed on a water tank or an air conditioning unit, both of which are substantially rectangular, the tarp will then be rectangular in shape, hence also taking on the shape of an architectural component. Regarding Wilhelmson and Meredith, applicant argues that they are non-analogous art because they teach attachments on different parts of a roof. However, they are both concerned with supporting objects on a roof. Applicant argues that Wilhelmson does not need to be adjustable; however, this discounts the

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possibility of wanting to support objects at different angles. Applicant then disagrees that Wilhelmson architecturally and aesthetically harmonizes with the building.

Applicant argues that the fake chimney cover meant to hide an uglier object in Wilhelmson does not actually match the house. However, applicant appears to be very narrowly interpreting "harmonize" and requiring the word to mean identical. However, harmonize is much broader than that – it only requires that the design works together with the house. Here, Wilhelmson teaches a chimney because it creates a design with the actual house of a house with a real chimney.

8. Regarding the possible changing in the shape of the cover, as again explained in the previous Non-final Office Action, applicant argues that shape is important because it results in a product which is distinct from the reference product. However, the shape here is merely ornamental; it is not functional. Whether the cover is in the shape of a chimney, balcony, skylight, etc, it's purpose and function is to hide a component. The tarp here meets that function, and is capable of being made into any necessary decorative shape. The tarp can also be decorated in any way desired; while applicant argues that having a design of a wall arrangement, window, grill, building bricks or panel elements creates a distinct product, the examiner still finds them functionally equivalent. Applicant argues that shape is important because chips are different than French fries, but in *Ex parte Hilton* the change in shape lead to a difference in specified moisture and fat content. In this case, there is no similar type of functional difference beyond the ornamentation itself; one design isn't stronger, or more durable, or more resistance to weather elements.



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9. Regarding the method claims, these arguments are again previously heard and rebutted in the previous Non-final office action. Applicant again appears to be arguing ornamentation; applicant argues that Solomon is directed towards covers that harmonize with a landscape rather than a building. However, Blue Hill Avenue teaches the method of harmonizing designs to buildings. While applicant asserts that the references could not be combined, Blue Hill just teaches a different design to be harmonized.

10. With regards to Drew and Cherkas being non-analogous art, Drew is used as teaching a cover; while Drew does not know how to create images on the cover, Cherkas teaches a technique of reproducing a decoration. In response to applicant's argument that Drew and Cherkas is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Cherkas solves the problem of how to decorate Drew and better disguise and blend in an element.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIZABETH A. PLUMMER whose telephone number is (571)272-2246. The examiner can normally be reached on Monday through Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eileen Lillis can be reached on (571) 272-6928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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